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# FEE TRANSMITTAL For FY 2005

FEB 16 2007

☒ Applicant claims small entity status. See 37 CFR 1.27

| TOTAL AMOUNT OF PAYMENT | ($) | 500.00 |
|---|---|---|

| Complete if Known | |
|---|---|
| Application Number | 09/743,649 |
| Filing Date | April 11, 2001 |
| First Named Inventor | Debbie Indira Lewis |
| Examiner Name | Jamie J. Vent |
| Art Unit | 2621 |
| Attorney Docket No. | RCA88650 |

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☑ Deposit Account Deposit Account Number: 07-0832 Deposit Account Name: Thomson Licensing, LLC

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☑ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

☑ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☑ Credit any overpayments

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## FEE CALCULATION

### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES Fee ($) | FILING FEES Small Entity Fee ($) | SEARCH FEES Fee ($) | SEARCH FEES Small Entity Fee ($) | EXAMINATION FEES Fee ($) | EXAMINATION FEES Small Entity Fee ($) | Fees Paid ($) |
|---|---|---|---|---|---|---|---|
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | |

### 2. EXCESS CLAIM FEES

| Fee Description | Fee ($) | Small Entity Fee ($) |
|---|---|---|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 200 | 100 |
| Multiple dependent claims | 360 | 180 |

| Total Claims | Extra Claims | Fee ($) | Fee Paid ($) |
|---|---|---|---|
| _____ - 20 or HP = | _____ | x _____ | = _____ |

HP = highest number of total claims paid for, if greater than 20.

| Indep. Claims | Extra Claims | Fee ($) | Fee Paid ($) |
|---|---|---|---|
| _____ - 3 or HP = | _____ | x _____ | = _____ |

HP = highest number of independent claims paid for, if greater than 3.

| Multiple Dependent Claims Fee ($) | Multiple Dependent Claims Fee Paid ($) |
|---|---|
| _____ | _____ |

### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee ($) | Fee Paid ($) |
|---|---|---|---|---|
| _____ - 100 = | _____ / 50 = | _____ (round up to a whole number) | x _____ | = _____ |

### 4. OTHER FEE(S)

| | Fees Paid ($) |
|---|---|
| Non-English Specification, $130 fee (no small entity discount) | |
| Other (e.g., late filing surcharge): Appeal Brief | $500.00 |

**SUBMITTED BY**

| | | | |
|---|---|---|---|
| Signature | | Registration No. (Attorney/Agent) 34,721 | Telephone 212-971-0416 |
| Name (Print/Type) | Jack Schwartz | | Date February 13, 2007 |

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Before the Board of Patent Appeals and Interferences**

Applicant : Debbie Indira Lewis

Serial No. : 09/743,649

Filed : April 11, 2001

For : DIGITAL VIDEO APPARATUS USER INTERFACE

Examiner : Jamie J. Vent

Art Unit : 2621

## APPEAL BRIEF

May It Please The Honorable Board:

Appellants appeal the Final Rejection dated October 2, 2006 of Claims 1-11 of the above-identified application. The fee of five hundred dollars ($500.00) for filing this Brief and any associated extension fee is to be charged to Deposit Account No. 07-0832. Enclosed is a single copy of this Brief.

Please charge any additional fee or credit any overpayment to the above-identified Deposit Account.

02/16/2007 YPOLITE1 00000064 070832 09743649
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Appellants do not request an oral hearing.

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**Certificate of Mailing under 37 CFR 1.8**

**I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in a postage paid envelope addressed to: Mail Stop: Appeal Briefs - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.**

Signature _____ Date: 2/13/07

## I. REAL PARTY IN INTEREST

The real party in interest of Application Serial No. 09/743,649is the Assignee of record:
Thomson Licensing S.A.

46 quai Alphonse Le Gallo

F-92100 Boulogne Billancourt

France

## II. RELATED APPEALS AND INTERFERENCES

There are currently, and have been, no related Appeals or Interferences regarding Application Serial No. 09/743,649.

## III. STATUS OF THE CLAIMS

Claims 1-11 are rejected and the rejection of claims 1-11 is appealed.

## IV. STATUS OF AMENDMENTS

All amendments were entered and are reflected in the claims included in Appendix I.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 provides a method of controlling a system for processing stored information on a storage medium, comprising the following steps (page 2, lines 26-28 and Fig. 5). Stored information is played back during a play mode of operation (page 2, lines 28-29 and Fig. 5, reference no. 127). A user is provided an opportunity, during play mode of operation, to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks, responsive to a user input (page 2, lines 29-31 and Fig. 5, reference no. 128). Playing back the stored information is changed from the

location corresponding to the selected bookmark during the play mode of operation. Providing to a user, during play mode of operation, an opportunity to select a bookmark (page 2, lines 29-31, page 8, lines 23-24 and Fig. 5, reference no. 128), as described above, includes determining a maximum number of the plurality of bookmarks which is associated with the storage medium. An on-screen menu (page 3, lines 5-6 and Fig. 4) displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium are generated (page 7, lines 30-32 and Fig. 5, reference no. 132). The menu allows the user to perform one of the following: (a) set a new bookmark (page 8, lines 2-5, page 9, lines 16-19, Fig. 4, reference no. 114), (b) select a bookmark and clearing the selected bookmark (page 9, lines 16-19, page 7, lines 1-2 and Fig. 4, reference no. 118), (c) select a bookmark and playback the stored information from the location corresponding to the selected bookmark (page 6, lines 5-6, page 7, lines 2-3, page 9, lines 16-19 and Fig. 4, reference no. 113), and (d) undo a previously performed operation (page 8, lines 15-18 and Fig. 4, reference no. 118). One of the previous is performed while continuing to watch program information playback in a background portion of the video display (page 8, lines 30-31 and Fig. 4, reference no. 118).

Dependent claim 2 includes all the features of independent claim 1 along with additional features of grouping the plurality of bookmarks into sets each having a predetermined number of bookmarks, storing each group of bookmarks, and providing to the user an opportunity to retrieve a desired set of bookmarks (page 2a, lines 3-8 and Fig. 5).

Dependent claim 3 includes all the features of independent claim 1 along with step (B) further comprising the step of providing to the user an opportunity to select a first and second

bookmark from among the plurality of bookmarks (page 8, lines 19-21 and Fig. 5, reference number 128), and step (C) further comprising the step of changing to playback the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark (page 7, lines 2-3 and Fig. 4, reference no. 113).

Dependent claim 4 includes all the features of the of dependent claim 3 along with step (C) further comprising the step of selectively continually repeating the playback of the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark, in response to user control (page 2a, lines 3-8 and Fig. 5, reference no. 136 and 138).

Dependent claim 5 includes all the features of independent claim 1 along with the storage medium being a DVD disk (page 1, lines 13-16, page 3, lines 1-4, Fig. 2 and Fig. 3) and the step of determining that the bookmarks actually present for the particular DVD disk comprises evaluating data related to the DVD disk in non-volatile memory in the player (page 7, lines 6-11 and Fig. 1, reference no. 24).

Dependent claim 6 includes all the features of the independent claim 1 along with step (B) being preceded by the step of determining whether a mode of operating enabling user access to bookmarks during play mode of operation is enabled (page 9, lines 16-21 and Fig. 6, reference no. 144) and performing steps (B) and (C) only if the mode of operation user access to bookmarks during play mode of operation is enabled (page 9, lines 19-21, page 9, lines 25-27 and Fig. 6, reference no. 144).

Dependent claim 7 includes all the features of independent claim 1 along with the additional feature that the system comprises a DVD player (page 2a, lines 11-12 and Fig. 1) and the storage medium comprises a DVD disk (page 1, lines 13-16, page 3, lines 1-4, Fig. 2 and Fig. 3).

Dependent claim 8 includes all the features of dependent claim 7 along with the step of setting a new bookmark in response to a user command comprising storing data associated with a pause function, including the nearest NAV_PACK address (page 5, lines 4-11 and Fig. 2), in conformance with the DVD specification (page 1, lines 13-16, page 3, lines 1-4, Fig. 2 and Fig. 3).

Dependent claim 9 includes all the features of dependent claim 8 along with the step of changing playback from a new bookmarked location comprising launching a user operative RESUME command (page 7, lines 12-13 and Fig. 1, reference no. 24), using a stored NAV_PACK address, in conformance with the DVD specification (page 7, lines 16-29 and Fig. 2).

Dependent claim 10 includes all the features of independent claim 1 along with step (C) further comprising the steps of selecting a first and second bookmark and continually repeating playing back the stored information from the location corresponding to the first selected bookmark to the location corresponding to the second selected bookmark (page 9, lines 6-7 and Fig. 5, reference no. 138).

Independent claim 11 provides an apparatus (page 1, lines 3-7 and Fig. 1) for processing information stored on a storage medium (page 3, lines 1-3, Fig. 2 and Fig. 3). The apparatus comprises a data processing unit (page 3, lines 27-29 and Fig. 1, reference no. 28) for accessing and processing information stored on the storage medium during play mode of operation of the apparatus. The apparatus also comprises a user control device for receiving user input (page 4, lines 15-18 and Fig. 1, reference no. 41), an on-screen display device (page 4, lines 8-9 and Fig. 1, reference no. 35) for generating on-screen displays (page 7, line 30 to page 8, line 5 and Fig. 4), and a controller (page 4, line 14 and Fig. 1, reference no. 40). The controller is coupled to the data processing unit, the user control device, and the on-screen display device, for activating the play mode of operation. During the play mode of operation, a user is provided an opportunity to access previously stored bookmarks (page 7, lines 9-10 and Fig. 4, reference no. 113), each bookmark representing a corresponding location at any point within the stored information. The controller determines a maximum number of the plurality of bookmarks which is associated with the storage medium, and which of the maximum number of the plurality of bookmarks are actually available for the storage medium (page 7, lines 25-27 and Fig. 5, reference no. 132). The on-screen display unit (page 4, lines 8-9 and Fig. 1, reference no. 35) generates an on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium (page 7, line 30 to page 8, line 5 and Fig. 4). The menu allows the user to perform one of the following: (a) set a new bookmark (page 8, lines 2-5, page 9, lines 16-19, Fig. 4, reference no. 114), (b) select a bookmark and clearing the selected bookmark (page 7, lines 1-2, page 9, lines 16-19 and Fig. 4, reference no. 118), (c) select a bookmark and playback the stored information from the location corresponding to the selected bookmark (page 6, lines 5-6, page 7, lines 2-3, page 9, lines 16-19 and Fig. 4, reference no. 113), and (d) allow the user

to undo a previously performed operation (page 8, lines 15-18 and Fig. 4, reference no. 118). One of the previous is performed while continuing to watch the information playback in a background portion of a video display (page 8, lines 30-31 and Fig. 5, reference no. 134).

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

**Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Custers (U.S. Patent 5,063,547) in view of Best (U.S. Patent 4, 569, 026) in further view of Ito et al. (U.S. Patent 5, 499, 221) in further view of Fujita et al. (U.S. Patent 5, 974, 219)**

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Custers (U.S. Patent 5,063,547) in view of Best (U.S. Patent 4, 569, 026) in further view of Ito et al. (U.S. Patent 5, 499, 221) in further view of Fujita et al. (U.S. Patent 5, 974, 219).

## VII. ARGUMENT

Custers in view of Best in further view of Ito et al. and in further view of Fujita et al. does not make claims 1-11 unpatentable. Thus, reversal of the rejection of claims 1-11 under 35 U.S.C. § 103(a) is respectfully requested. Reversal of the Final Rejection (hereinafter termed "rejection") of claims 1-11 under 35 U.S.C. § 103(a) is respectfully requested.

Overview of the Cited References

Custers et al. describes a compact-disc digital audio player in which different users, independently of one another, can store preferred selections of specific discs in a memory. The player identifies the discs from the sub-code on the disc. The user identification can be entered in the player. The user identification and the record carrier identification are combined to form one identification code. The player also detects whether a preferred selection program is stored in the memory associated with the identification code. If an identification code is stored, the player reproduces the relevant information from the disc in the sequence specified by the preferred-selection program.

Best describes a video entertainment system by which human viewers conduct simulated voice conversation with screen actors or cartoon characters in a branching story game shown on a television screen. Different audio and video frames are generated from a videodisc and data memory to provide one of several alternative replies or alternative actions at each branch point in the game, depending on what the viewer says to a speech-recognition unit.

Ito et al. describe a portable CD-ROM retrieval apparatus. A CD-ROM drive loads a CD medium. A color liquid crystal display shows characters and images and similar information output of the CD-ROM drive and showing a menu. A joypad directing device selects a desired menu item. An audio output circuit outputs audio information such as music or voice. These components are integrated in a single unit.

Fujita et al. describe a control method for detecting change points in motion picture images to extract desired video cut during a single playing operation of the video image, and the

video image can be edited in a high efficiency. When a user designates a frame of a video image under playing operation, a detection is made of a change point in the video cut containing this designated form in both forward and reverse playing direction.

**Rejection of Claims 1-11 under 35 USC 103(a) over Custers (U.S. Patent 5,063,547) in view of Best (U.S. Patent 4, 569, 026) in further view of Ito et al. (U.S. Patent 5, 499, 221) in further view of Fujita et al. (U.S. Patent 5, 974, 219)**

Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. does not make claims 1-11 unpatentable. Thus, reversal of the rejection of claims 1-11 under 35 U.S.C. § 103(a) is respectfully requested. Reversal of the Final Rejection (hereinafter termed "rejection") of claims 1-11 under 35 U.S.C. § 103(a) is respectfully requested.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed.Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed.Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 28,

293, 227 USPQ 657, 664 (Fed.Cir. 1985), *cert. denied,* 475 U.S. 1017 (1986); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir. 1992).

CLAIM 1

The present claimed invention provides a method for controlling a system for processing stored information on a storage medium. Stored information is played back during a play mode of operation and the user is provided an opportunity to select a bookmark representing a corresponding location at any point within the stored information from among a plurality of bookmarks responsive to the user's input during play mode. The stored information is played back from the location corresponding to the selected bookmark during the play mode of operation. An on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium is generated. The user is allowed to perform one of setting a new bookmark; selecting a bookmark and clearing the selected bookmark; selecting the bookmark and playing back the stored information from the location corresponding to the selected bookmark; and undoing a previously performed operation while continuing to watch program information playback in a background portion of the video display. In response to a user selecting a bookmark, the playback circuitry retrieves information from the storage medium starting at the location corresponding to the selected one of a plurality of bookmarks during the play mode of operation. This eliminates the need to press fast-forward to scroll to the user's desired point in

the video. Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. neither disclose nor suggest the features of the present claimed invention.

The Office Action contends that Custers discloses a method of controlling a system for processing stored information on a storage medium similarly to the present invention. Applicants respectfully disagree. Custers describes a compact-disc digital audio player that can store a preferred selection of specific discs in a memory for multiple users independently of one another. Custers neither discloses nor suggests bookmarks "representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in claim 1 of the present invention. Conventional media disc menus are configured such that the user can begin playback from the starting point of a selected video title or chapter. The menus, however, do not allow the user to select an arbitrary point within a video title or chapter for starting playback. On the other hand, the present claimed invention allows the user to set bookmarks "representing a corresponding location at any point within the stored information" as recited in claim 1. By providing for bookmarks to be set at any point within the stored information, the present claimed invention provides users with the convenience of jumping to a pre-selected location within a video title or chapter in response to user input without having to manipulate the various transport keys in order to locate and start the playback.

Furthermore, Fig. 3 of Custers, cited by the Office Action, shows an example of an identification block. The block comprises the disc identification code RID, the user identification code UN, the location of the next block L and the sequence number of the relevant

disc within the selection of discs DN (Col. 4, lines 35-43). Custers merely allows users to store selections of discs where the storage is based on a unique identification code of a compact disc. Nowhere in the above passage or anywhere in Custers is there mention of the features of the present claimed invention. More specifically, Custers does not provide the "user ... an opportunity to select a bookmark representing a corresponding location at any point within the stored information" as recited in the present claimed invention. Therefore, Custers(with Best, Ito et al. and Fujita et al. discussed herein below) neither discloses nor suggests "providing to a user ... an opportunity to select a bookmark representing a corresponding location at any point within the stored information" as recited in claim 1 of the present invention.

In column 3, lines 7-10, Custers states that "[t]he player has the possibility of storing preferred program selections of a plurality of discs in a memory, identifying, discs to be played and, if desired, playing the preferred program selection." Although bookmarks are nowhere mentioned in Custers, the "preferred program selection" in Custers may represent bookmarks of specific tracks on discs. The "preferred program selection" in Custers, however, is NOT "a bookmark representing a corresponding location at any point within the stored information" as recited in claim 1 of the present invention.

The Office Action further asserts that Col. 6, lines 20-29 of Custers "describes the selection of bookmark/flags to be used" (Rejection, page 3) as in the present claimed invention. Applicants respectfully disagree. Column 6, lines 20-29 of Custers describes putting on a disc and initializing parameters, "such as the parameters A which indicate the address in the preferred-selection memory 6 and F which is a flag which is used in the program" (Col. 6, lines 22-25). These parameters, however, do not provide a user an opportunity to select a bookmark which

represents a corresponding location with the stored information during play mode of operation as in the present claimed invention. Therefore, Custers (with Best, Ito et al. and Fujita et al.) neither discloses nor suggests "providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" as recited in claim 1 of the present invention.

Additionally, as admitted in the Office Action, Custers neither discloses nor suggests "providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input; a menu allowing the user to perform one of the following: set a new bookmark, selecting a bookmark and clearing the selected bookmark, selecting a bookmark and playback the stored information from the location corresponding to the selected bookmark, and undo a previously performed operation while continuing to watch the program information playback in a background portion of the video display; providing the user the opportunity to select a bookmark, representing a corresponding location at any point within the stored information" as in the present claimed invention.

Best allows the user to interact with a video entertainment system via voice commands. In Best, points in a game are represented by special story commands which can point to several subsequent chains of story commands. These chains of commands, however, do not allow the user to "set a new bookmark", nor do they allow the user the ability to "select a bookmark and clearing the selected bookmark" as recited in independent claim 1 of the present invention. The prompted commands are predetermined by the game system, not the user.

The Office Action contends that Best "discloses a video entertainment system wherein prompted commands/bookmarks prompts the user to choose the outcome of the current program while in playback mode as described in Column 9 Lines 15-23" (Rejection, page 4) and is similar to the present claimed invention. Applicants respectfully disagree. Column 9, lines 15-23 of Best describes story commands and cue commands. "Cue commands specify what is to happen during an interval of time. Story commands represent points in time, and form chains which define each alternative story line. Branch points in the game, when a viewer can choose among alternatives, are represented by special story commands which can point to several subsequent chains of story command" (Col. 9, lines 16-22). To the contrary, the present claimed invention, during play mode of operation, provides a user an opportunity to select a bookmark representing a corresponding location at any point within the stored information. In Best, predetermined "story commands" representing points in time are stored in a video game so that when a user issues a command by speaking, the corresponding response to the command is generated. This is accomplished by entering into an alternative mode in the game, based on the issued command to select the outcome of a game character. This is wholly unlike the present claimed invention, as the present invention allows the user to set a bookmark which corresponds to a point the user wishes to re-watch, and allows playback of the stored information from the location corresponding to the selected bookmark. Therefore, Best, similar to Custers, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests

"(B) providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input; and

(C) changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation, wherein (B) includes ... the menu allowing the user to perform one of:

(a) set a new bookmark;

(b) select a bookmark and clearing the selected bookmark,

(c) select a bookmark and play back the stored information from the location corresponding to the selected bookmark..." as recited in claim 1 of the present claimed invention.

Furthermore, the objective of Best is to provide a user with an interactive method of playing a game or watching a movie and therefore, simulating "Movies That Talk Back." To the contrary, the objective of the present claimed invention is to provide a user with the opportunity to set a bookmark representing a location which the user wishes to store in memory so that it can be played back at that exact location without implementing fast forwarding, rewinding or skipping. Best does not address the issue of allowing users to store a bookmarked location to refer back to as in the present claimed invention. Therefore, Best, similar to Custers, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests "providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input; and ... set[ting] a new bookmark ..." as recited in claim 1 of the present invention.

Ito et al. describes a portable CD-ROM retrieval apparatus. A CD-ROM drive loads a CD medium. A color liquid crystal display shows characters and images and similar information output of the CD-ROM drive and showing a menu. A joypad directing device

selects a desired menu item. An audio output circuit outputs audio information such as music or voice. These components are integrated in a single unit. The Office Action asserts that Ito et al. disclose a CD-ROM retrieval apparatus which retrieves a position wherein the user has left a bookmark at any position on the recording medium in Col. 16, lines 25-34. Applicants respectfully disagree. While Ito et al. can store position information such as last read page and line, and "automatically retrieves the position which is to start reading" (Ito et al., Col. 12, lines 29-31), the apparatus does not actually store bookmarks in response to user input as in the present claimed invention. The Office Action states that the last read page and line feature of Ito et al. "provide ... the user the opportunity to retrieve information from any point on the recording medium and thereby allows the entire data to be very easily accessed." However, information is not retrieved from any point on the recording medium, but rather only the last visited page stored in memory is retrieved. Thus Ito et al., similarly to Custers and Best, neither discloses nor suggests "providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in claim 1 of the present invention.

Furthermore, the objective of Ito et al. is to "provide an integrated CD-ROM retrieval apparatus that can show a menu on a display (color liquid crystal display) for selecting a desired menu item with direction of a simple joypad, having no ROM pack containing the retrieving program" (Col. 2, lines 8-12). Such an all-in-one device does not address the issues solved by the present claimed invention in which the objective is to provide a user with the opportunity to set a bookmark representing a location which the user wishes to store in memory so that it can be

played back at that exact location without implementing fast forwarding, rewinding or skipping. Therefore, Ito et al., similarly to Custers and Best, neither disclose nor suggest a method "for processing information stored on a storage medium, comprising: ...providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in claim 1 of the present claimed invention.

Fujita et al. describes a control method for detecting change points in motion picture images to extract desired video cut during a single playing operation of the video image, and the video image can be edited in a high efficiency. When a user designates a frame of a video image under playing operation, a detection is made of a change point in the video cut containing this designated form in both forward and reverse playing direction. Fujita et al., similarly to Custer, Best, and Ito et al., neither disclose nor suggest "select[ing] a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user inputs" and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in the present claimed invention. While Fujita et al. allow a user to designate a frame of a video image under playing operation and "automatically detecting a change point of a video cut based upon a feature amount of the digital signal with respect to each of the frames of the video image" (Col. 4, lines 59-61), the method does not change playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation. In fact, Fujita et al. merely describe a method for allowing a user to designate a

frame for the purpose of editing image data and are not concerned with setting a bookmark for playing back the stored information from the location corresponding to the bookmark. Thus, Fujita et al. describe a fundamentally different method than the present claimed invention and fail to disclose or suggest a selected bookmark and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in claim 1 of the present invention.

Additionally, Fujita et al. in Col. 16, lines 5+, cited by the Office Action, describe a flow chart of a process flow in a mark setting operation. However, marking the frame in Fujita et al. is wholly unlike the present claimed invention which selects a bookmark "representing a corresponding location at any point within the stored information." The objective of Fujita et al. is to merely mark the frame in order to cut the video for the purpose of editing image data. The objective of Fujita et al. is not at all related to the objective of the present claimed invention which is to provide a user with the opportunity to set a bookmark representing a location which the user wishes to store in memory so that it can be played back at that exact location without implementing fast forwarding, rewinding or skipping. Therefore, Fujita et al., when taken alone or in any combination with Custers, Best and Ito et al., neither disclose nor suggest "providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" as recited in claim 1 of the present invention.

Applicants respectfully submit that there is no motivation or reason to combine Custers, Best, Ito et al. and Fujita et al. Best, contrary to Custers, Ito et al. and Fujita et al., provides an interactive video entertainment system that responds to voice commands to play the appropriate

programs in response to the commands. Best combines an apparatus for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands. Custers provides for users to make selections to be stored in memory prior to playback while the Best system requires that the user, in an interactive video entertainment environment, make a selection while a media disc is being played. Ito et al. provide a CD-ROM retrieval apparatus. Ito et al. do not provide storage of user preferences. Fujita et al., contrary to Custers, Best, and Ito et al., provide a method for editing frames of image data by detecting a change point in the image data. Fujita et al. allow a user to pick a frame for the purpose of editing while Custers provides for users to make track selections for playback. Additionally, these references are responsive to different problems and thus it is respectfully submitted that there is no reason or motivation to combine these references and thus, the combination of these references to produce the present claimed invention would not be obvious. Custers involves making "selection of preferred programs...rapid and reliable" (Col. 2, lines 8-11) while Best provides an interactive video game which creates an "illusion of individualized and active participation in a two-way conversation" (Col. 2, lines 4-7). On the other hand, Ito et al. are involved in making a more effective CD-ROM retrieval system (Col. 2, lines 13-18) while Fujita et al. provide a method of editing image data in a high efficiency (Col. 6, lines 3-14). Thus, the combination of the systems of Custers, Best, Ito et al. and Fujita et al. would provide for a CD-ROM retrieval system that requires a user to predetermine a sequence for playback while also requiring a user to make a selection during playback of a media disc and automatically detecting user selection for the purpose of editing image data. Consequently, it is respectfully submitted that the operation of the systems of Custers, Best, Ito et al. and Fujita et al. are conflicting and thus there is no motivation or reason to combine Custers, Best, Ito et al. and Fujita et al. and even if combined, the combination does not yield the present invention.

However, even if one were to combine the four systems, the combination would produce a CD-ROM retrieval digital audio player for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands and that can store preferred selections of specific discs in a memory and edit user-selected frames of image data. This combination would still not allow a user to retrieve a bookmark representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input and change playback of the stored information from the location corresponding to the selected bookmark during the play mode of operation. Therefore, similar to the individual systems, the combination of the systems of Custers, Best, Ito et al. and Fujita et al. neither disclose nor suggest retrieving bookmarks "representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input" and "changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation" as recited in claim 1 of the present invention.

Furthermore, the combination of each reference must provide the invention as claimed, without the benefit of hindsight provided by the application. The present claimed invention provides a user an opportunity to select a bookmark representing a corresponding location at any point within stored information from among a plurality of bookmarks responsive to user input and the stored information is played back from the location corresponding to the selected bookmark during the play mode of operation. Thus, a user will be able to select an arbitrary point within the stored information without the need to press fast-forward to scroll to the user's desired point in the video. These functions are not disclosed in any of the cited references. It is thus respectfully submitted that the arguments of obviousness of the Office Action are based

upon picking selected passages from each of the cited references based on knowledge obtained from the present application and therefore are based on impermissible hindsight.

In view of the above remarks, Applicants respectfully submit that Custers, Best, Ito et al., and Fujita et al., when taken alone or in any combination, provide no 35 USC 112 compliant enabling disclosure that makes claim 1 unpatentable. Therefore, Applicants further respectfully submit that this rejection has been satisfied and should be withdrawn.

CLAIM 2

Dependent claim 2 provides the method of claim 1, and further comprises the steps of: grouping the plurality of bookmarks into sets each having a predetermined number of bookmarks, storing each group of bookmarks, and providing to the user an opportunity to retrieve a desired set of bookmarks. Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. neither discloses nor suggests the features of the present claimed invention.

Custers describes a compact-disc digital audio player in which different users can store preferred selections of specific discs in memory. The Office Action states that Custers discloses a method similar to the present claimed invention. Applicants respectfully disagree. Figure 2, cited by the Office Action, displays an index table which is present on every disc comprising "serial data in the form of groups" (Col. 3, line 22). A disc identification code (RID) is derived from the information to be reproduced or from a subcode supplied by the decoder circuit. However, Custers nowhere suggests or discloses grouping of bookmarks, as in the present

claimed invention. Furthermore, the Office Action on page 5 of the Rejection cites Col. 4, lines 9-11 as describing "storing each group of bookmarks." Applicants respectfully disagree. The above passage specifically states "[t]he identification code ID thus obtained, together with the preferred selection, is stored in the memory." Although identification codes and the disc selections of users are stored into memory in Custers, these are not groups of bookmarks, as in the present claimed invention. Moreover, Custers does not even mention bookmarks in his invention as Custers is concerned with storing selections of compact discs in memory and allowing the user to access the preferred selection. Even if the "preferred selection" in Custers represented bookmarks of specific tracks on discs, the "preferred selection", however, neither discloses nor suggests bookmarks "representing a corresponding location at any point within the stored information" as recited in the independent claims of the present invention. Therefore, Custers in view of Best ,in further view of Ito et al. in and further view of Fujita et al. neither discloses nor suggests "[t]he method of claim 1, further comprising the steps of: grouping the plurality of bookmarks into sets each having a predetermined number of bookmarks; storing each group of bookmarks ..." as recited in claim 2 of the present invention.

Furthermore, the present claimed invention provides to the user an opportunity to retrieve a desired set of bookmarks. The Office Action argues that Custers describes this feature. Applicants respectfully disagree. Custers does not allow users to select bookmarks, where the bookmarks represent "a corresponding location at any point within the stored information" as recited in claim 1 of the present invention. Custers merely allows users to store selections of discs where the storage is based on a unique identification code of a compact disc. Col. 4, lines 45-50 of Custers describes the last block in Fig. 3. The "block comprises a variable number of bytes MFT representing the selection made by the user" (Col. 4, lines 46-47). "Since this

selection can be made in different ways, it may be required to have bits which indicate the type of addressing (track numbers, index or time) and merging bits" (Col. 4, lines 47-50). Nowhere in the above passage or anywhere in Custers is there mention of the features of the present claimed invention. More specifically, Custers does not provide the user an opportunity to retrieve a desired set of bookmarks as in the present claimed invention. Therefore, Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. neither discloses nor suggests "providing to the user an opportunity to retrieve a desired set of bookmarks" as recited in claim 2 of the present invention.

In view of the above remarks, Applicants respectfully submit that Custers, Best, Ito et al., and Fujita et al., when taken alone or in any combination, provide no 35 USC 112 compliant enabling disclosure that makes claim 2 unpatentable. Therefore, Applicants further respectfully submit that this rejection has been satisfied and should be withdrawn.

CLAIM 3

Dependent claim 3 provides the method of claim 1, wherein step (B) further comprises the step of providing to the user an opportunity to select a first and second bookmark from among the plurality of bookmarks, and step (C) further comprises the step of changing to playback the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark. Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. neither discloses nor suggests the features of the present claimed invention.

The Office Action states that Custers "discloses a system that changes the playback of stored information corresponding to location of data of a bookmark" on page 6 of the Rejection. Applicants respectfully disagree. Figure 1, element 6, cited by the Office Action, contains the ID code and preferred selection memory. The ID code comprises the number of minutes and seconds of a track, the number of tracks on a disc and the user identification. Although Custers' system contains a memory, the stored information does not change to playback from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark, as in the present claimed invention. Rather, Custers is only concerned with storing preferred selections of discs in memory, where different users can independently store preferred selections. Even if the "preferred selection" in Custers represented bookmarks of specific tracks on discs, the "preferred selection", however, neither discloses nor suggests bookmarks "representing a corresponding location at any point within the stored information" as recited in the independent claims of the present invention. Thus, Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. neither discloses nor suggests "[t]he method of claim 1, wherein: ... step (C) further comprises the step of changing to playback the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark" as recited in claim 3 of the present invention.

As admitted by the Office Action on page 6 of the Rejection, Custers "lacks to provide a user an opportunity to select a first and second bookmark from among the plurality of bookmarks." However, Best also neither shows or suggests such a feature. Col. 9, lines 15-27 of Best, cited by the Office Action, describes the control information of Best's system. The control information includes story commands and cue commands. "Cue commands specify what is to

happen during an interval of time" (Col. 9, lines 16-17) and "[s]tory commands represent points in time, and form chains which define each alternate story line" (Col. 9, lines 17-19). "Branch points in the game, when a viewer can choose among alternatives, are represented by special story commands which can point to several subsequent chains of story command" (Col. 9, lines 19-22). To the contrary, the present claimed invention, during play mode of operation, provides a user an opportunity to select a bookmark representing a corresponding location at any point within the stored information (claim 1). The present claimed invention in claim 3 further comprises the step of changing to playback the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark. In Best, predetermined "story commands" representing points in time are stored in a video game so that when a user issues a command by speaking, the corresponding response to the command is generated. This is accomplished by entering into an alternative mode in the game, based on the issued command to select the outcome of a game character. This is wholly unlike the present claimed invention, as the present invention allows the user to set a bookmark which corresponds to a point the user wishes to re-watch, and allows playback of the stored information from the location corresponding to the selected bookmark, further comprising the step of changing to playback the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark. Therefore, Best, similar to Custers, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests "[t]he method of claim 1, wherein: step (B) further comprises the step of providing to the user an opportunity to select a first and a second bookmark from among the plurality of bookmarks" as recited in claim 3 of the present invention.

Furthermore, the objective of Best is to provide a user with an interactive method of playing a game or watching a movie and therefore, simulating "Movies That Talk Back." To the contrary, the objective of the present claimed invention is to provide a user with the opportunity to set a bookmark representing a location which the user wishes to store in memory so that it can be played back at that exact location without implementing fast forwarding, rewinding or skipping. Best does not address the issue of allowing users to store a bookmarked location to refer back to as in the present claimed invention. Therefore, Best, similar to Custers, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests "[t]he method of claim 1, wherein: step (B) further comprises the step of providing to the user an opportunity to select a first and a second bookmark from among the plurality of bookmarks" as recited in claim 3 of the present invention.

In view of the above remarks, Applicants respectfully submit that Custers, Best, Ito et al., and Fujita et al., when taken alone or in any combination, provide no 35 USC 112 compliant enabling disclosure that makes claim 3 unpatentable. Therefore, Applicants further respectfully submit that this rejection has been satisfied and should be withdrawn.

CLAIMS 4 and 10

Dependent claims 4 and 10 are dependent on claims 1 and 3, respectively, and all above arguments apply to each of these claims. Claim 4 describes the method of claim 3, wherein step (C) further comprises the step of selectively continually repeating the playback of the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark, in response to user control. Claim 10

describes the method of claim 1, wherein step (C) further comprises the steps of selecting a first and second bookmark and continually repeating playing back the stored information from the location corresponding to the first selected bookmark to location corresponding to the second selected bookmark. Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. neither discloses nor suggests the features of the present claimed invention.

Custers describes a compact-disc digital audio player in which different users can store preferred selections of specific discs in memory. The Office Action on page 6 of the Rejection states that Custers "discloses a method wherein the step of selectively continually repeating the playback of the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of ... another bookmark, in response to user control (Column 3 Lines 7-20 describe the storing of selections as well as changing the selection when user selects another bookmark to be used)." Applicants respectfully disagree. Col. 3, lines 7-20 describe a compact-disc audio player having the possibility of storing preferred program selections of a plurality of discs in memory, identifying discs to be played, and if desired, playing the preferred program selection. The "microcomputer 3 is program[m]ed to derive a disc identification code RID from the subcode supplied by the decoder circuit 5. The disc identification code RID may be, for example, a catalog number contained in this subcode or an indication of a composer, performer, title etc. ... it is more advantageous to derive a disc-identification code RID from data present on every disc" (Col. 3, lines 11-19). However, the identifying code and the selected discs (also referred to as "preferred selection") in Custers are wholly unlike the present claimed invention which describes bookmarks. The use of bookmarks is nowhere mentioned in Custers. Even if the "preferred selection" in Custers represented bookmarks of specific tracks on discs, the "preferred selection", however, neither discloses nor

suggests bookmarks "representing a corresponding location at any point within the stored information" as recited in the independent claims of the present invention. Furthermore, Custers allows users to select a disc to play, but nowhere shows or suggests continually repeating playback as in the present claimed invention. Therefore, Custers neither discloses nor suggests "[t]he method of claim 3, wherein step (C) further comprises the step of selectively continually repeating the playback of the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark, in response to user control" as recited in claim 4 and "[t]he method of claim 1, wherein step (C) further comprises the steps of selecting a first and second bookmark and continually repeating playing back the stored information from the location corresponding to the first selected bookmark to location corresponding to the second selected bookmark" as recited in claim 10 of the present invention.

Additionally, on page 6 of the Rejection (arguing against claim 3), the Office Action admits that Custers "lacks to provide a user an opportunity to select a first and second bookmark." Applicants respectfully submit that if the user in Custers is not able to select a first and second bookmark, as admitted in the Office Action, a user is not able to perform the method of claim 4 and claim 10. Thus, Custers does not select any bookmarks as disclosed in claims 4 and 10 of the present invention.

Even Best, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., does not show or suggests such features. Col. 9, lines 15-27 of Best, argued by the Office Action against claim 3, describes the control information of Best's system. The control information includes story commands and cue commands. "Cue commands specify what is to happen during

an interval of time" (Col. 9, lines 16-17) and "[s]tory commands represent points in time, and form chains which define each alternate story line" (Col. 9, lines 17-19). "Branch points in the game, when a viewer can choose among alternatives, are represented by special story commands which can point to several subsequent chains of story command" (Col. 9, lines 19-22). To the contrary, the present claimed invention, during play mode of operation, provides a user an opportunity to select a bookmark representing a corresponding location at any point within the stored information (claim 1). The present claimed invention in claim 3 further comprises the step of changing to playback the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark. In Best, predetermined "story commands" representing points in time are stored in a video game so that when a user issues a command by speaking, the corresponding response to the command is generated. This is accomplished by entering into an alternative mode in the game, based on the issued command to select the outcome of a game character. This is wholly unlike the present claimed invention, as the present invention allows the user to set a bookmark which corresponds to a point the user wishes to re-watch, and allows playback of the stored information from the location corresponding to the selected bookmark, further comprising the step of changing to playback the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark. Therefore, Best, similar to Custers, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests the features described in claims 1 and 3 of the present invention. As claims 4 and 10 are dependent on claims 1 and 3, respectively, Applicants respectfully submit that these claims are also allowable for the same reasons as claims 1 and 3.

Furthermore, the objective of Best is to provide a user with an interactive method of playing a game or watching a movie and therefore, simulating "Movies That Talk Back." To the contrary, the objective of the present claimed invention is to provide a user with the opportunity to set a bookmark representing a location which the user wishes to store in memory so that it can be played back at that exact location without implementing fast forwarding, rewinding or skipping. Best does not address the issue of allowing users to store a bookmarked location to refer back to as in the present claimed invention. Therefore, Best, similar to Custers, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests "[t]he method of claim 3, wherein step (C) further comprises the step of selectively continually repeating the playback of the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark, in response to user control" as recited in claim 4 and "[t]he method of claim 1, wherein step (C) further comprises the steps of selecting a first and second bookmark and continually repeating playing back the stored information from the location corresponding to the first selected bookmark to location corresponding to the second selected bookmark" as recited in claim 10 of the present invention.

In view of the above remarks, Applicants respectfully submit that Custers, Best, Ito et al., and Fujita et al., when taken alone or in any combination, provide no 35 USC 112 compliant enabling disclosure that make claims 4 and 10 unpatentable. Therefore, Applicants further respectfully submit that this rejection has been satisfied and should be withdrawn.

CLAIMS 5 and 7

Dependent claims 5 and 7 are considered to be patentable based on their dependence on claim 1 and it is respectfully submitted that these claims are allowable for the same reasons as discussed above regarding claim 1. Additionally, claim 5 provides that the storage medium is a DVD disk, and wherein, the step of determining the bookmarks actually present for the particular DVD disk comprises evaluating data related to the DVD disk in non-volatile memory in the disk player. Claim 7 provides that the system comprises a DVD player and the storage medium comprises a DVD disk. Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. neither discloses nor suggests the features of the present claimed invention.

Claims 5 and 7 of the present invention disclose implementing a DVD player capable of playing audio, video and data disks. Custers describes a compact-disc player capable of playing audio. A video player (such as a DVD player in the present claimed invention) can utilize a bookmark feature in order to replay a favorite scene, pause a video at a certain point for a later return and play only desired selections of the video as in the present claimed invention. On the other hand, there is no reason or motivation to bookmark a position on an audio disc track such as the CD player of Custers. The CD player merely plays audio discs by track number and a user may easily play tracks in any order that he desires. Therefore, unlike with a DVD player which provides both audio and video data, there is no reason or motivation to use a bookmark feature, as in the present claimed invention, with the CD player of Custers. However, even the compact-disc player of Custers, which is not the same as a video DVD player, does not describe the features of the present invention. More specifically, Custers does not even mention bookmarks in his invention as Custers is concerned with storing selections of compact discs in memory and allowing the user to access the preferred selection. The determination of bookmarks in the present

claimed invention is nowhere shown or suggested in Custers. Even if the "preferred selection" in Custers represented bookmarks of specific tracks on disks, the "preferred selection", however, neither discloses nor suggests bookmarks "representing a corresponding location at any point within the stored information" as recited in the independent claims of the present invention. Therefore, Custers, when taken alone or in any combination with Best, Ito et al. and Fujita et al., neither discloses nor suggests that "the storage medium is a DVD disk, and wherein: the step of determining the bookmarks actually present for the particular DVD disk comprises evaluating data related to the DVD disk in non-volatile memory in the disk player" as recited in claim 5 and that "the system comprises a DVD player and the storage medium comprises a DVD disk" as recited in claim 7 of the present invention.

Additionally, the Office Action on page 6 argues that "determining the bookmarks actually present for the particular CD disk [in Custers] comprises evaluating data related to the CD disk in non-volatile memory in the disk player (Column 2 Lines 12+)." Applicants respectfully disagree. As discussed in the above, Custers does not determine bookmarks as in the present claimed invention. Col. 2, lines 12+ of Custers merely describes an "apparatus for reproducing audio information encoded in conformity with the 'Compact Disc Digital Audio' standard" (Col. 2, lines 12-14). Furthermore, there is no reason or suggestion to bookmark the position of an audio disc track in Custers. The Office Action on page 7 further states that "it is obvious to one skilled in the art at the time of the invention to incorporate a DVD system, over Custers et al system comprising a CD player, in order to allow the user easier accessibility as well as a larger storage medium." Applicants respectfully submit that a DVD system is wholly unlike the CD player of Custers and there is no motivation or reason to combine the two. A CD player, as described by Custers, plays audio compact discs. A user may jump to any track on the audio compact disc by skipping to the

desired track. To the contrary, a DVD player is capable of playing video disks. The present claimed invention allows for users to implement bookmarks which "allow a user to select an arbitrary point within a video title or chapter for starting playing. For example, a user may have a favorite point in the middle of the video title or a chapter in which to start playback. The user also may wish to avoid the inconvenience of manipulating the fast forward or reverse commands to reach the precise point desired" (Specification, page 2, lines 4-9). This feature is not needed and is not mentioned in Custers. Therefore, as the audio compact disc player of Custers is wholly unlike the DVD player containing a bookmark feature as in the present claimed invention, Custers neither discloses nor suggests that "the storage medium is a DVD disk, and wherein: the step of determining the bookmarks actually present for the particular DVD disk comprises evaluating data related to the DVD disk in non-volatile memory in the disk player" as recited in claim 5 and that "the system comprises a DVD player and the storage medium comprises a DVD disk" as recited in claim 7 of the present invention.

In view of the above remarks, Applicants respectfully submit that Custers, Best, Ito et al., and Fujita et al., when taken alone or in any combination, provide no 35 USC 112 compliant enabling disclosure that make claims 5 and 7 unpatentable. Therefore, Applicants further respectfully submit that this rejection has been satisfied and should be withdrawn.

CLAIM 6

Dependent claim 6 is considered to be patentable based on its dependence on claim 1 and it is respectfully submitted that this claim is allowable for the same reasons as discussed above regarding claim 1. Claim 6 is also considered to be patentable because Custers with Best with Ito et al. with Fujita et al., taken in any combination, does not show or suggest "[t]he method of claim

1, wherein step (B) is preceded by the step of determining whether a mode of operation enabling user access to bookmarks during play mode of operation is enabled; and performing steps (B) and (C) only if the mode of operation user access to bookmarks during play mode of operation is enabled" as recited in the present invention.

The Office Action on page 7 of the Rejection states that Custers discloses a method of determining whether a bookmark is selected. Applicants respectfully disagree. Custers does not mention bookmarks anywhere in his invention as Custers is concerned with storing selections of compact discs in memory and allowing the user to access the preferred selection. Even if the "preferred selection" in Custers represented bookmarks of specific tracks on discs, the "preferred selection", however, neither discloses nor suggests bookmarks "representing a corresponding location at any point within the stored information" as recited in the independent claims of the present invention. Therefore, Custers, when taken alone or in any combination with Best, Ito et al. and Fujita et al., neither discloses nor suggests "[t]he method of claim 1, wherein step (B) is preceded by the step of determining whether a mode of operation enabling user access to bookmarks during play mode of operation is enabled; and performing steps (B) and (C) only if the mode of operation user access to bookmarks during play mode of operation is enabled" as recited in claim 6 of the present invention.

The Office Action correctly asserts that Custers "lacks a mode of operation enabling user access to bookmarks during play mode of operation is enabled" on page 7 of the Rejection. However, Best also does not describe such a feature. Best allows human viewers to conduct simulated voice conversations with screen actors or cartoon characters in a branching story game shown on a television screen. Best does not mention bookmarks, as in the present claimed

invention. Best contains a "comparator 69 which compares the binary code on line 71 with the condition code on line 68 from a succession of branch commands in register 65" (Col. 13, lines 54-57). If the user issues a response, the comparator detects the response and continues on with the next story command. Best, however, does not use the comparator to enable or disable access to bookmarks, as Best merely uses the comparator to compare if the user responses are inappropriate or not. Furthermore, Best is unable to perform "step[s] (B) ... and (C) only if the mode of operation user access to bookmarks during play mode of operation is enabled", as in the present claimed invention. Best, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests "[t]he method of claim 1, wherein step (B) is preceded by the step of determining whether a mode of operation enabling user access to bookmarks during play mode of operation is enabled; and performing steps (B) and (C) only if the mode of operation user access to bookmarks during play mode of operation is enabled" as recited in claim 6 of the present invention.

In view of the above remarks, Applicants respectfully submit that Custers, Best, Ito et al., and Fujita et al., when taken alone or in any combination, provide no 35 USC 112 compliant enabling disclosure that makes claim 6 unpatentable. Therefore, Applicants further respectfully submit that this rejection has been satisfied and should be withdrawn.

CLAIMS 8 and 9

Dependent claim 8 provides the method of claim 7, wherein the step of setting a new bookmark in response to a user command comprises storing data associated with a pause function, including the nearest NAV_PACK address, in conformance with the DVD specification. Dependent claim 9 describes the method of claim 8, wherein the step of changing

playback from a new bookmarked location comprises launching a user operative RESUME command, using a stored NAV_PACK address, in conformance with the DVD specification. Custers in view of Best, in further view of Ito et al. and in further view of Fujita et al. neither discloses nor suggests the features of the present claimed invention.

Custers describes a compact-disc player capable of playing audio, not a DVD player as in the present claimed invention. However, even if the compact-disc player of Custers was equivalent to a DVD player, the compact disc player of Custers does not describe the features of the present invention. More specifically, Custers does not even mention bookmarks in his invention as Custers is concerned with storing selections of compact discs in memory and allowing the user to access the preferred selection. The determination of bookmarks in the present claimed invention is neither shown nor suggested in Custers. Even if the "preferred selection" in Custers represented bookmarks of specific tracks on discs, the "preferred selection", Custers still neither discloses nor suggests bookmarks "representing a corresponding location at any point within the stored information" as recited in the independent claims of the present invention. Furthermore, the Office Action correctly admits that Custers "lacks comprises storing data associated with a pause and resume function, including the nearest NAV_PACK address, in conformance with the DVD specification" on page 7 of the Rejection. However, Applicants respectfully disagree with the assertion in the Office Action that a pause and resume function, as in the present claimed invention, can be used in Custers. Custers' audio compact-disc player as described does not contain a NAV_PACK address as in the present claimed invention. Therefore, Custers, when taken alone or in any combination with Best, Ito et al. and Fujita et al., neither discloses nor suggests "[t]he method of claim 7, wherein the step of setting a new bookmark in response to a user command comprises storing data associated with a pause function, including

the nearest NAV_PACK address, in conformance with the DVD specification" as recited in claim 8 and "[t]he method of claim 8, wherein the step of changing playback from a new bookmarked location comprises launching a user operative RESUME command, using a stored NAV_PACK address, in conformance with the DVD specification" as recited in claim 9 of the present invention.

In view of the above remarks, Applicants respectfully submit that Custers, Best, Ito et al., and Fujita et al., when taken alone or in any combination, provide no 35 USC 112 compliant enabling disclosure that make claims 8 and 9 unpatentable.

As claims 8 and 9 are dependent on independent claim 1, it is respectfully submitted that these claims are patentable for the same reasons as the independent claim. Therefore, Applicants further respectfully submit that this rejection has been satisfied and should be withdrawn.

CLAIM 11

Independent claim 11 provides an apparatus for processing information stored on a storage medium. The apparatus comprises a data processing unit for accessing and processing information stored on a storage medium during play mode of operation of the apparatus, a user control device for receiving user input, an on-screen display device for generating on-screen displays, and a controller. The controller is coupled to the data processing unit, the user control device, and the on-screen display device, for activating the play mode of operation and providing to a user during the play mode of operation an opportunity to access previously stored bookmarks. Each bookmark represents a corresponding location at any point within the stored information, wherein the controller determines a maximum number of the plurality of bookmarks which is

associated with the storage medium, and which of the maximum number of the plurality of bookmarks are actually available for the storage medium. The on-screen display unit generates an on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium. The menu allows the user to perform one of the following: set a new bookmark, select a bookmark and clear the selected bookmark, select a bookmark and playback the stored information from the location corresponding to the selected bookmark, and allow the user to undo a previously performed operation while continuing to watch the information playback in a background portion of a video display. These features are not shown or suggested by Custers, Best, Ito et al. and Fujita et al., when taken alone or in any combination.

The Office Action contends that Custers discloses an apparatus (of controlling a system) for processing stored information on a storage medium similarly to the present invention. Applicants respectfully disagree. Custers describes a compact-disc digital audio player that can store preferred selection of specific discs in a memory for multiple users independently of one another. Custers neither discloses nor suggests bookmarks "representing a corresponding location at any point within the stored information" and "providing to a user during the play mode of operation an opportunity to access previously stored bookmarks" as recited in claim 11 of the present invention. Conventional media disc menus are configured such that the user can begin playback from the starting point of a selected video title or chapter. The menus, however, do not allow the user to select an arbitrary point within a video title or chapter for starting playback. However, the present claimed invention allows the user to access previously stored bookmarks "representing a corresponding location at any point within the stored information" as recited in claim 11 of the present invention. By providing for bookmarks to be set at any point within the

stored information, the present claimed invention provides users with the convenience of jumping to a pre-selected location within a video title or chapter in response to user input without having to manipulate the various transport keys in order to locate and start the playback.

Furthermore, Fig. 3 of Custers, cited by the Office Action, shows an example of an identification block. The block comprises the disc identification code RID, the user identification code UN, the location of the next block L and the sequence number of the relevant disc within the selection of discs DN (Col. 4, lines 35-43). Custers merely allows users to store selections of discs where the storage is based on a unique identification code of a compact disc. Nowhere in the above passage or anywhere in Custers is there mention of the features of the present claimed invention. More specifically, Custers does not allow the user to perform one of the following "set a new bookmark ... select a bookmark and" clear "the selected bookmark" and provide "to a user during the play mode of operation an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within the stored information" as in the present claimed invention. Therefore, Custers, with Best, Ito et al. and Fujita et al. discussed herein below, neither discloses nor suggests a bookmark "representing corresponding location at any point within the stored information" as recited in claim 11 of the present invention.

In column 3, lines 7-10, Custers states that "[t]he player has the possibility of storing preferred program selections of a plurality of discs in a memory, identifying, discs to be played and, if desired, playing the preferred program selection." Although bookmarks are nowhere mentioned in Custers, the "preferred program selection" in Custers may represent bookmarks of specific tracks on discs. The "preferred program selection" in Custers, however, neither disclose

nor suggest bookmarks "representing a corresponding location at any point within the stored information" as recited in claim 11 of the present invention.

The Office Action states that Col. 6, lines 20-29 of Custers "describes the selection of bookmark/flags to be used" (Rejection, page 3) as in the present claimed invention. Applicants respectfully disagree. Column 6, lines 20-29 of Custers describes putting on a disc and initializing parameters, "such as the parameters A which indicate the address in the preferred-selection memory 6 and F which is a flag which is used in the program" (Col. 6, lines 22-25). These parameters, however, do not provide a user, during the play mode of operation, an opportunity to access previously stored bookmarks which represents a corresponding location with the stored information as in the present claimed invention. Therefore, Custers in view of Best in further view of Ito et al. in further view of Fujita et al. neither discloses nor suggests "providing to a user during the play mode of operation an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within the stored information" as recited in claim 11 of the present invention.

Additionally, as admitted in the Office Action, Custers neither discloses nor suggests "providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input; a menu allowing the user to perform one of the following: set a new bookmark, selecting a bookmark and clearing the selected bookmark, selecting a bookmark and playback the stored information from the location corresponding to the selected bookmark, and undo a previously performed operation while continuing to watch the program information playback in a background portion of the video display; providing the user

the opportunity to select a bookmark, representing a corresponding location at any point within the stored information."

Best allows the user to interact with the video entertainment system via voice commands. In Best, points in the game are represented by special story commands which can point to several subsequent chains of story commands. These chains of commands, however, do not allow the user to "set a new bookmark", nor do they allow the user the ability to "select a bookmark and clearing the selected bookmark" as recited in independent claim 11 of the present invention. The prompted commands are predetermined by the game system, not the user.

The Office Action contends that Best "discloses a video entertainment system wherein prompted commands/bookmarks prompts the user to choose the outcome of the current program while in playback mode as described in Column 9 Lines 15-23" (Rejection, page 4) and is similar to the present claimed invention. Applicants respectfully disagree. Column 9, lines 15-23 of Best describes story commands and cue commands. "Cue commands specify what is to happen during an interval of time. Story commands represent points in time, and form chains which define each alternative story line. Branch points in the game, when a viewer can choose among alternatives, are represented by special story commands which can point to several subsequent chains of story command" (Col. 9, lines 16-22). To the contrary, the present claimed invention, during play mode of operation, provides a user an opportunity to access previously stored bookmarks representing a corresponding location at any point within the stored information. In Best, predetermined "story commands" representing points in time are stored in a video game so that when a user issues a command by speaking, the corresponding response to the command is generated. This is accomplished by entering into an alternative mode in the game, based on the

issued command to select the outcome of a game character. This is wholly unlike the present claimed invention, as the present invention allows the user to set a bookmark which corresponds to a point the user wishes to re-watch, and allows playback of the stored information from the location corresponding to the selected bookmark. Therefore, Best, similar to Custers, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests "providing to a user during the play mode of operation an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within the stored information, wherein ... the on-screen menu allow[s] the user to perform one of:

(a) set a new bookmark;

(b) select a bookmark and clearing the selected bookmark,

(c) select a bookmark and playing back the stored information from the location corresponding to the selected bookmark, and

(d) allow the user to undo a previously performed operation

while continuing to watch the information playback in a background portion of a video display" as recited in claim 11 of the present claimed invention.

Furthermore, the objective of Best is to provide a user with an interactive method of playing a game or watching a movie and therefore, simulating "Movies That Talk Back." To the contrary, the objective of the present claimed invention is to allow the user to set a bookmark and provide the user, during the play mode of operation, an opportunity to access previously stored bookmarks, where each bookmark represents a location which the user wishes to store in memory so that it can be played back at that exact location without implementing fast forwarding, rewinding or skipping. Best does not address the issue of allowing users to store a bookmarked location to refer back to as in the present claimed invention. Therefore, Best,

similar to Custers, when taken alone or in any combination with Custers, Ito et al. and Fujita et al., neither discloses nor suggests "providing to a user during the play mode of operation an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within the stored information ... [and] set[ting] a new bookmark ..." as recited in claim 11 of the present invention.

Ito et al. describe a portable CD-ROM retrieval apparatus. A CD-ROM drive loads a CD medium. A color liquid crystal display shows characters and images and similar information output of the CD-ROM drive and showing a menu. A joypad directing device selects a desired menu item. An audio output circuit outputs audio information such as music or voice. These components are integrated in a single unit. The Office Action asserts that Ito et al. disclose a CD-ROM retrieval apparatus which retrieves a position wherein the user has left a bookmark at any position on the recording medium in Col. 16, lines 25-34. Applicants respectfully disagree. While Ito et al. can store position information such as last read page and line, and "automatically retrieves the position which is to start reading" (Ito et al., Col. 12, lines 29-31), the apparatus does not actually allow a user to set a new bookmark and provide to a user, during the play mode of operation, access to previously stored bookmarks. The Office Action states that the last read page and line feature of Ito et al. "provide ... the user the opportunity to retrieve information from any point on the recording medium and thereby allows the entire data to be very easily accessed." However, information is not retrieved from any point on the recording medium, but rather only the last visited page stored in memory is retrieved. Thus Ito et al., similarly to Custers and Best, neither disclose nor suggest "providing to a user during the play mode of operation an opportunity to access previously stored

bookmarks, each bookmark representing a corresponding location at any point within the stored information" as recited in claim 11 of the present invention.

Furthermore, the objective of Ito et al. is to "provide an integrated CD-ROM retrieval apparatus that can show a menu on a display (color liquid crystal display) for selecting a desired menu item with direction of a simple joypad, having no ROM pack containing the retrieving program" (Col. 2, lines 8-12). Such an all-in-one device does not address the issues solved by the present claimed invention in which the objective is to allow the user to set a bookmark and during play mode of operation, provide the user an opportunity to access previously stored bookmarks representing a corresponding location at any point within the stored data so that it can be played back at that exact location without implementing fast forwarding, rewinding or skipping. Therefore, Ito et al., similarly to Custers and Best, and when taken alone or in any combination with Custers, Best and Fujita et al., neither disclose nor suggest an apparatus "for processing information stored on a storage medium, comprising: ...providing to a user during the play mode of operation an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within the stored information" and "an on-screen menu ... allowing the user to .. set a new bookmark" as recited in claim 11 of the present claimed invention.

Fujita et al. describes a control method for detecting change points in motion picture images to extract desired video cut during a single playing operation of the video image, and the video image can be edited in a high efficiency. When a user designates a frame of a video image under playing operation, a detection is made of a change point in the video cut containing this designated form in both forward and reverse playing direction. Fujita et al., similar to

Custer, Best, and Ito et al., neither disclose nor suggest providing to a user access to bookmarks, "each bookmark represent[s] a corresponding location at any point within the stored information" as recited in the present claimed invention. While Fujita et al. allow a user to designate a frame of a video image under playing operation and "automatically detecting a change point of a video cut based upon a feature amount of the digital signal with respect to each of the frames of the video image" (Col. 4, lines 59-61), the method does not change playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation. In fact, Fujita et al. merely describe a system for allowing a user to designate a frame for the purpose of editing image data and are not concerned with setting a bookmark or accessing previously stored bookmarks representing a corresponding location at any point within the stored information as in the present claimed invention. Thus, Fujita et al. describe a fundamentally different method than the present claimed invention and fail to disclose or suggest a selected bookmark and "providing to a user during the play mode of operation an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within the stored information" as recited in claim 11 of the present invention.

Additionally, Fujita et al. in Col. 16, lines 5+, cited by the Office Action, describe a flow chart of a process flow in a mark setting operation. However, marking the frame in Fujita et al. is wholly unlike the present claimed invention which selects a bookmark and accesses previously stored bookmarks "representing a corresponding location at any point within the stored information." The objective of Fujita et al. is to merely mark the frame in order to cut the video for the purpose of editing image data. The objective of Fujita et al. is not at all related to the objective of the present claimed invention which is to provide a user, during play mode of

operation, an opportunity to access previously stored bookmarks representing a corresponding location at any point within the stored information so that a desired bookmarked location can be played back without implementing fast forwarding, rewinding or skipping. Therefore, Fujita et al., when taken alone or in any combination with Custers, Best and Ito et al., neither disclose nor suggest "providing to a user during the play mode of operation an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within the stored information" as recited in claim 11 of the present invention.

Applicants respectfully submit that there is no motivation or reason to combine Custers, Best, Ito et al. and Fujita et al. Best, contrary to Custers, Ito et al. and Fujita et al., provides an interactive video entertainment system that responds to voice commands to play the appropriate programs in response to the commands. Best combines an apparatus for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands. Custers provides for users to make selections to be stored in memory prior to playback while the Best system requires that the user, in an interactive video entertainment environment, make a selection while a media disc is being played. Ito et al. provide a CD-ROM retrieval apparatus. Ito et al. do not provide storage of user preferences. Fujita et al., contrary to Custers, Best, and Ito et al., provide a method for editing frames of image data by detecting a change point in the image data. Fujita et al. allow a user to pick a frame for the purpose of editing while Custers provides for users to make track selections for playback. Additionally, these references are responsive to different problems and thus it is respectfully submitted that that there is no reason or motivation to combine these references and thus, the combination of these references to produce the present claimed invention would not be obvious. Custers involves making "selection of preferred programs...rapid and reliable" (Col.

2, lines 8-11) while Best provides an interactive video game which creates an "illusion of individualized and active participation in a two-way conversation" (Col. 2, lines 4-7). On the other hand, Ito et al. are involved in making a more effective CD-ROM retrieval system (Col. 2, lines 13-18) while Fujita et al. provide a method of editing image data in a high efficiency (Col. 6, lines 3-14). Thus, the combination of the systems of Custers, Best, Ito et al. and Fujita et al. would provide for a CD-ROM retrieval system that requires a user to predetermine a sequence for playback while also requiring a user to make a selection during playback of a media disc and automatically detecting user selection for the purpose of editing image data. Consequently, it is respectfully submitted that the operation of the systems of Custers, Best, Ito et al. and Fujita et al. are conflicting and thus there is no motivation or reason to combine Custers, Best, Ito et al. and Fujita et al. and even if combined, the combination does not yield the present invention.

However, even if one were to combine the four systems, the combination would produce a CD-ROM retrieval digital audio player for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands and that can store preferred selections of specific discs in a memory and edit user-selected frames of image data. This combination would still not allow a user to set a bookmark representing a corresponding location at any point within the stored information, and access previously stored bookmarks as in the present claimed invention. Therefore, similar to the individual systems, the combination of the systems of Custers, Best, Ito et al. and Fujita et al. neither disclose nor suggest accessing previously stored bookmarks "representing a corresponding location at any point within the stored information" and "an on-screen menu ... allowing the user to ... set a new bookmark" as recited in claim 11 of the present invention.

Furthermore, the combination of each reference must provide the invention as claimed, without the benefit of hindsight provided by the application. The present claimed invention provides a user an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within stored information. The present claimed invention also provides an on-screen menu that allows the user to set a new bookmark and select a bookmark and clear the selected bookmark. Thus, a user will be able to set an arbitrary point within the stored information without the need to press fast-forward to scroll to the user's desired point in the video. These functions are not disclosed in any of the cited references. It is thus respectfully submitted that the arguments of obviousness of the Office Action are based upon picking selected passages from each of the cited references based on knowledge obtained from the present application and therefore are based on impermissible hindsight.

In view of the above remarks, Applicants respectfully submit that Custers, Best, Ito et al., and Fujita et al., when taken alone or in any combination, provide no 35 USC 112 compliant enabling disclosure that makes claim 11 unpatentable. Therefore, Applicants further respectfully submit that this rejection has been satisfied and should be withdrawn.

## VIII CONCLUSION

Custers, Best, Ito et al. and Fujita et al., when taken alone or in any combination, do not describe a method and apparatus for controlling a system for processing stored information on a storage medium as in the present claimed invention. The present claimed invention allows

playing back of stored information during a play mode of operation, providing to a user, during play mode of operation, an opportunity to select a bookmark, and changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation. The bookmark in the present claimed invention represents a corresponding location at any point within the stored information. This is nowhere mentioned or suggested in Custers, Best, Ito et al. and Fujita et al., when taken alone or in any combination. Custers, Best, Ito et al. and Fujita et al. all describe different systems where Custers describes an audio compact-disc player capable of storing individual selections of specific discs in memory; Best describes a video entertaining system in which human viewers can conduct simulated voice conversations with screen actors or cartoon characters in a story game on a television screen; Ito et al. describe a portable CD-ROM retrieval apparatus for loading a CD medium, viewing the CD-ROM on an attached display and a data storage for storing data from the CD-ROM drive; and Fujita et al. describe a video cut system containing a frame designated by a user that is automatically and correctly extracted directly from a video image under playing operation at high speed. Custers, Best, Ito et al. and Fujita et al., when taken alone or in any combination, do not describe selecting bookmarks representing corresponding locations at any point within the stored information as in the present claimed invention. Custers, Best, Ito et al. and Fujita et al., when taken alone or in any combination, do not even address the problem of existing systems, in which the user cannot avoid the inconvenience of manipulating the fast forward or reverse commands to reach a precise desired point in a movie, etc. The present claimed invention not only addresses this problem but offers a unique solution where the user can bookmark any point in a movie and jump directly to the bookmarked point without tediously searching for it using fast forward or rewind. Therefore, Custers, Best, Ito et al. and Fujita et al., when taken alone or in any combination, neither disclose nor suggest a method and apparatus for controlling a system

for "processing stored information on a storage medium ... providing to a user during" a "play mode of operation" "an opportunity to" select or access a bookmark, where the bookmark represents "a corresponding location at any point within the stored information" as in the present claimed invention. As dependent claims 2-10 are dependent on independent claim 1, it is respectfully submitted that these claims are patentable for the same reasons as claim 1. Accordingly it is respectfully submitted that the rejection of claims 1-11 should be reversed.

Respectfully submitted,
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## APPENDIX I - APPEALED CLAIMS

1. (Previously Presented) A method of controlling a system for processing stored information on a storage medium, comprising the steps of:

(A) playing back stored information during a play mode of operation;

(B) providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input; and

(C) changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation, wherein (B) includes

determining a maximum number of the plurality of bookmarks which is associated with the storage medium;

generating an on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium, the menu allowing the user to perform one of:

(a) set a new bookmark;

(b) select a bookmark and clearing the selected bookmark,

(c) select a bookmark and play back the stored information from the location corresponding to the selected bookmark, and

(d) undo a previously performed operation

while continuing to watch program information playback in a background portion of the video display.

2. (Previously Presented) The method of claim 1, further comprising the steps of:

grouping the plurality of bookmarks into sets each having a predetermined number of bookmarks;

storing each group of bookmarks; and

providing to the user an opportunity to retrieve a desired set of bookmarks

3. (Previously Presented) The method of claim 1, wherein:

step (B) further comprises the step of providing to the user an opportunity to select a first and a second bookmark from among the plurality of bookmarks, and

step (C) further comprises the step of changing to playback the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark.

4. (Previously Presented) The method of claim 3, wherein step (C) further comprises the step of selectively continually repeating the playback of the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the second bookmark, in response to user control.

5. (Previously Presented) The method of claim 1, wherein the storage medium is a DVD disk, and wherein:

the step of determining the bookmarks actually present for the particular DVD disk comprises evaluating data related to the DVD disk in non-volatile memory in the disk player.

6. (Previously Presented) The method of claim 1, wherein step (B) is preceded by the step of determining whether a mode of operation enabling user access to bookmarks during play mode of operation is enabled; and

performing steps (B) and (C) only if the mode of operation user access to bookmarks during play mode of operation is enabled.

7. (Previously Presented) The method of claim 1, wherein the system comprises a DVD player and the storage medium comprises a DVD disk.

8. (Previously Presented) The method of claim 7, wherein the step of setting a new bookmark in response to a user command comprises storing data associated with a pause function, including the nearest NAV_PACK address, in conformance with the DVD specification.

9. (Previously Presented) The method of claim 8, wherein the step of changing playback from a new bookmarked location comprises launching a user operative RESUME command, using a stored NAV_PACK address, in conformance with the DVD specification.

10. (Previously Presented) The method of claim 1, wherein step (C) further comprises the steps of selecting a first and second bookmark and continually repeating playing back the stored information from the location corresponding to the first selected bookmark to location corresponding to the second selected bookmark.

11. (Previously Presented) Apparatus for processing information stored on a storage medium, comprising:

a data processing unit for accessing and processing information stored on the storage medium during the play mode of operation of the apparatus;

a user control device for receiving user input;

an on-screen display device for generating on-screen displays; and

a controller, coupled to the data processing unit, the user control device, and the on-screen display device, for activating the play mode of operation, and providing to a user during the play mode of operation an opportunity to access previously stored bookmarks, each bookmark representing a corresponding location at any point within the stored information, wherein

the controller determines a maximum number of the plurality of bookmarks which is associated with the storage medium, and which of the maximum number of the plurality of bookmarks are actually available for the storage medium, and

the on-screen display unit generates an on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium, the menu allowing the user to perform one of:

(a) set a new bookmark;

(b) select a bookmark and clearing the selected bookmark,

(c) select a bookmark and playing back the stored information from the location corresponding to the selected bookmark, and

(d) allow the user to undo a previously performed operation

while continuing to watch the information playback in a background portion of a video display.

## APPENDIX II - EVIDENCE

Applicants do not rely on any additional evidence other than the arguments submitted hereinabove.

## APPENDIX III - RELATED PROCEEDINGS

Applicants respectfully submit that there are no proceedings related to this appeal in which any decisions were rendered.

## APPENDIX IV - TABLE OF CASES

1. *In re Howard*, 394 F. 2d 869, 157 USPQ 615, 616 (CCPA 1968)
2. 29 AM. Jur 2D Evidence S. 33 (1994)
3. *In re Ahlert*, 424 F. 2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)
4. *In re Eynde*, 480 F. 2d 1364, 1370; 178 USPQ 470, 474 (CCPA 1973)
5. *In re Fine*, 5 USPQ 2d 1600, (Fed Cir. 1988)
6. ACS Hospital Systems Inc v. Montefiore Hospital, 221 USPQ 929,933 (Fed. Cir. 1984)
7. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (CCPA 1966)
8. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed.Cir. 1988), *cert. denied*, 488 U.S. 825 (1988)
9. *Ashland Oil Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 28, 293, 227 USPQ 657, 664 (Fed.Cir. 1985), *cert. denied,* 475 U.S. 1017 (1986)
10. *In re Oetiker,* 977 F2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)
11. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)

## APPENDIX V - LIST OF REFERENCES

| U.S. Pat. No. | Issued Date | 102(e) Date | Inventors |
|---|---|---|---|
| 5,063,547 | November 5, 1991 | | Custers |
| 4,569,026 | February 4 1986 | | Best |
| 5,499,221 | March 12, 1996 | | Ito |
| 5,974,219 | October 26, 1986 | | Fujita |

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